

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/801,309

Applicant: William E. Italia et al.

Filed: March 16, 2004

TC/AU: 2617

Examiner: HOLLIDAY, JAIME MICHELE

Docket No.: 252274 (Client Reference No. GP-304136)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

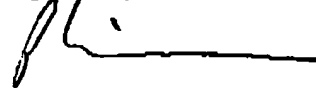
Applicants request review of the final rejections in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.


The review is requested for the reasons stated on the following sheets.

Respectfully submitted,



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Date: September 18, 2006

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Name (Print/Type)	Jennifer J Ramirez		
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*REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW*

Claims 1-20 are pending in this application. Of these, claims 1, 11, and 16 are independent. Each of these independent claims stands rejected under 35 U.S.C. §102 for alleged anticipation by Howe (U.S. 6,876,855) (hereinafter "Howe").<sup>1</sup>

There are clear errors in the Final Office Action's application of Howe to the pending independent claims.<sup>2</sup> As a result, a prima facie showing of unpatentability has not been made with regard to *any* of the presently pending claims. The full set of pending claims can be found at pages 2-6 of the Amendment filed on July 17, 2006.

The claimed subject matter pertains generally to a technique for assigning a mobile dialing number to a wireless mobile communication device, so that calls to the mobile device from its base station are local. For example, a call from a base station such as a garage location, dispatch center, etc. to the mobile device can be made without incurring long distance calls, regardless of the distance between the two, because the mobile device is assigned a local *phone number* relative to the base address. The claims focus on particular systems for reaching this goal.

Claim 1 is illustrative of the rejected independent claims, and is reproduced below for the reader's convenience:

1. A method for assigning a mobile dialing number (MDN) to a wireless mobile communication device (MCD) for providing local call access to the MCD from a base address for the MCD, the method comprising:

selecting a wireless rate center encompassing the base address and having an MDN providing local call access to the MCD from the base address for the MCD; and

assigning the MDN providing local calling access to the MCD from the base address for the MCD, in the selected wireless rate center encompassing the base address, to the MCD.

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<sup>1</sup> Although the action states that Howe is U.S. 6,615,381, this appears to be a typographical error, as this number identifies a patent to Fukuda and not Howe. The form 892 attached to the first action correctly lists the number for Howe as 6,876,855. This error has been noted to the Examiner on two occasions without response, so it is assumed that this interpretation of what reference was intended is correct.

<sup>2</sup> Although there are further errors in the rejections, it is not necessary to address these at this time, because reversal of the rejections of the independent claims will moot these issues.

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Reasons for Withdrawal of Rejection

As noted above, all independent claims stand rejected as allegedly anticipated by Howe. However, as discussed hereinafter, it is readily apparent that Howe simply fails to teach the recited claim elements of any of the presently pending claims. The pending independent claims recite the steps of (or means for, or computer-readable code for) [a] selecting a wireless rate center encompassing the base address and having a mobile dialing number providing local call access to the mobile communication device from its base address, and [b] assigning the mobile dialing number to the mobile device.

In contrast, Howe operates in an entirely different manner. Howe simply assures that the *last* infrastructure hop during a call to a mobile device is a local – not the entire call from the base address to the mobile device. This is a fundamental difference. Although Howe thus fails to teach *any* limitation of any of the independent claims, the following paragraphs will focus on a single limitation to make the point with the greatest brevity.

Independent Claims 1, 11, and 16:

*“...assigning the MDN [mobile dialing number] ... to the MCD [mobile communication device]...”*

Howe:

Howe does not teach any requirement whatsoever regarding assigning a number to the mobile device. The Office Actions state that the “temporary local directory number” taught in Howe is to be compared to the “mobile dialing number” recited in the claim. See Final Action dated April 17, 2006 at page 2, last paragraph; see also pages 4-5.

However, there is a clear and fundamental problem with this theory—each and every claim requires assigning the number *to the mobile device*, and yet Howe assigns its “temporary local directory number” *to a serving switch*. See Howe at 3:41-43 (“The VLR searches for the serving switch and assigns *to it* a temporary local directory number (TLDN)”). As is clear from Howe, and as admitted in the Office Actions, the only mobile

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device in Howe is the "mobile terminal," not the serving switch.<sup>3</sup> This clear and critical error in applying Howe stems from the profound mismatch between the teachings of Howe and the features of the present invention.

Because each of claims 1, 11, and 16 contains express limitations that are clearly absent from Howe, the rejections of these claims under §102 in view of Howe are not proper, and reversal of the Final Action dated April 17, 2006 is respectfully requested.

Moreover, since each of claims 2-10, 12-15, and 17-20 depends from one of the foregoing independent claims, it is respectfully submitted that these dependent claims are also patentable over Howe, asserted alone or in combination, for the reasons discussed above.

#### Conclusion

As illustrated by the example above, Howe fails to teach the limitations of the pending claims. Thus, the primary reversible error is that each rejection cites Howe for at least one teaching that Howe simply does not contain, and reversal is respectfully requested.

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<sup>3</sup> See Howe Abstract ("... optimizing the routing of a call originated from a land-based terminal (43) to a wireless mobile terminal (47) ..."); see also Office Action dated November 9, 2005, page 3 and Office Action dated April 17, 2006, pages 2-3 (Both actions indicating that the presently recited mobile communication device is to be compared to Howe's mobile terminal). Although this issue has been repeatedly raised by the applicants, it appears that no response has been provided.